

REMARKS**Status Of The Claims**

Claims 14-16, 18 and 21-25 were previously pending. Claims 21 and 25 have been amended to recite that in the plasma-etching step, "particles on the entire surface of the protective layer are removed to make a smooth surface". Support for this amendment can be found, for example, on page 12, lines 4-5 of the application as filed. No new matter has been added by these amendments.

Claims 14-16, 18 and 21-25 remain pending and at issue.

Rejections Under 35 U.S.C. § 103(a)**I. Claims 21-24**

Claims 21-24 stand rejected as obvious over U.S. Patent No. 5,635,037 to Chu (hereafter "Chu") in view of JP-08 315356 to Honda (hereafter "Honda").

In the Amendment filed on March 17, 2005, Applicants argued that Chu and Honda use matter deposited on the protective layer as masks, and therefore do not teach or suggest the limitation "plasma etching . . . wherein particles on the surface of the protective layer are removed." In response, the Examiner stated that the plasma etching disclosed in Chu teaches this limitation, since Chu removes those particles that are not protected by the masking particles.

Claim 21 has been amended to specify that particles on the *entire* surface of the protective layer are removed to make a smooth surface. Since Chu and Honda use particles as masks, they do not teach or suggest plasma etching . . . wherein particles on the *entire* surface of the protective layer are removed. Accordingly, the cited references do not teach or suggest the limitations of claim 21, or claims 23-24 which depend therefrom.

II. Claims 14-16, 18 and 21-25

Claims 14-16, 18 and 21-25 stand rejected as obvious over Chu in view of Honda and further in view of U.S. Patent No. 4,816,334 to Yokoyama et al. (hereafter "Yokoyama"). Applicants have previously argued that the plasma etching step in Yokoyama is merely optional, and is employed merely to improve bonding with the top-coat layer. In response thereto, the Examiner states that:

"[T]he fact that the applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious."

(emphasis supplied herein, citation omitted)". Applicants respectfully disagree with the applicability of this statement in at least two respects.

First, the above statement presumes that the person of ordinary skill in the art would be motivated to follow the relied-upon disclosure in the prior art, i.e., would be motivated to provide a plasma etching technique without masking. Without benefit of the present application, however, a person of ordinary skill would *not* be motivated to necessarily employ the plasma etching technique, since Yokoyama teaches that such techniques are not necessary to improve error rates or required in order to obtain a working embodiment (See Sample No. 18 in Table 1 of Yokoyama). Accordingly, Applicants respectfully submit that reliance on the above passage is misplaced.

Second, the above passage is based on the principle that minimization of surface defects and enhancement of surface quality naturally flows from the claimed plasma etching technique. This is not apparent based on Yokoyama itself, or other art cited by the Examiner. As stated above, Yokoyama provides an embodiment in which plasma etching is not used and the error rate is zero (Sample No. 18). Accordingly, there is no basis in the cited art for the proposition that minimization of surface defects and improvement of surface quality -- and hence, reduction of error

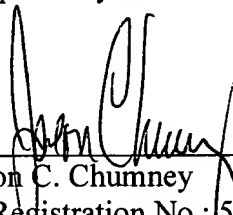
rates -- would naturally flow from plasma etching as instantly claimed. The only basis for such an assertion is derived from the present disclosure.

To advance prosecution, claims 21 and 25 have been amended to specify that particles are removed from the entire surface of the protective layer. This limitation is not disclosed or suggested in Chu or Honda. Reliance on Yokoyama is based on the impermissible use of hindsight, and unfair based on the disclosure of Yokoyama itself. Accordingly, Applicant requests that the obviousness rejections be withdrawn.

Applicants believe that the pending application is in condition for allowance. If an interview would be helpful, the Examiner is requested to contact the undersigned attorney at the number listed below.

Respectfully submitted,

Dated: January 23, 2006

By 
Jason C. Chumney
Registration No.: 54,781
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7637
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant